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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,240	01/21/2004	Kia Silverbrook	WAL10US	2184

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, NSW 2041  
AUSTRALIA

EXAMINER
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FERGUSON, MARISSA L

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/760,240

Applicant(s)

SILVERBROOK ET AL.

Examiner

Marissa L. Ferguson

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The terminal disclaimer filed on 9/19/05 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 10/760,256 and 10/760,239 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: "and to slot the web of wallpaper" in line 10 needs to be changed to "and to slit the web of the wallpaper". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3, 4, 11, 12, 14, 17, 18, 20,22,33,39,40-43,46,47,49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Martin (US Publication 2002/0171692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900).

Regarding claims 1, 3, 4, 11, 22, 33,39, 40-43, 47, 49 and 51 ,Martin teaches an on-demand printer (18) comprising a cabinet/frame (housing of printer 18 and refer to figure on page 4) in which is located a media path (look at figure on page 5) which extends from a media (27) loading area to a printhead (20) and from the printhead to a dispensing slot (refer to figure on page 4), the printer having one or more printer input devices (36,37) which communicate with a processor (38 and paragraph 0009) to capture data regarding one or more customer requirements including changing a pattern (paragraph 0010) , the data comprising at least a customer selected pattern (paragraph 0010, Lines 7-11), providing the franchisee with a collection of patterns in a digital storage medium (30) that can be read by the printer, enabling the franchisee to print a roll of wallpaper, onto a web of blank media, on demand, according to the selected pattern (Abstract), winding area (26 and refer to figure on page 5 of office action) adapted to removably retain a core (core can be removed by reversing the process) and wind onto it, wallpaper produced by paper. With regards to obtaining a fee the consumer transaction is considered to be implicitly anticipated because it is known to exchange a fee for a product.

However, Martin does not teach a printer that allows the customer to select a width and a printer that is used to slit a web. Fujii et al. teaches calculating an amount of wallpaper required by the customer based on room dimensions such as width supplied by customers (Figures 6,7 and 9). However, he does not disclose cutting/slitting a web. Kwasny teaches a slitting/cutting mechanism (16) for slitting a web. It would have been obvious to one of ordinary skill to modify the

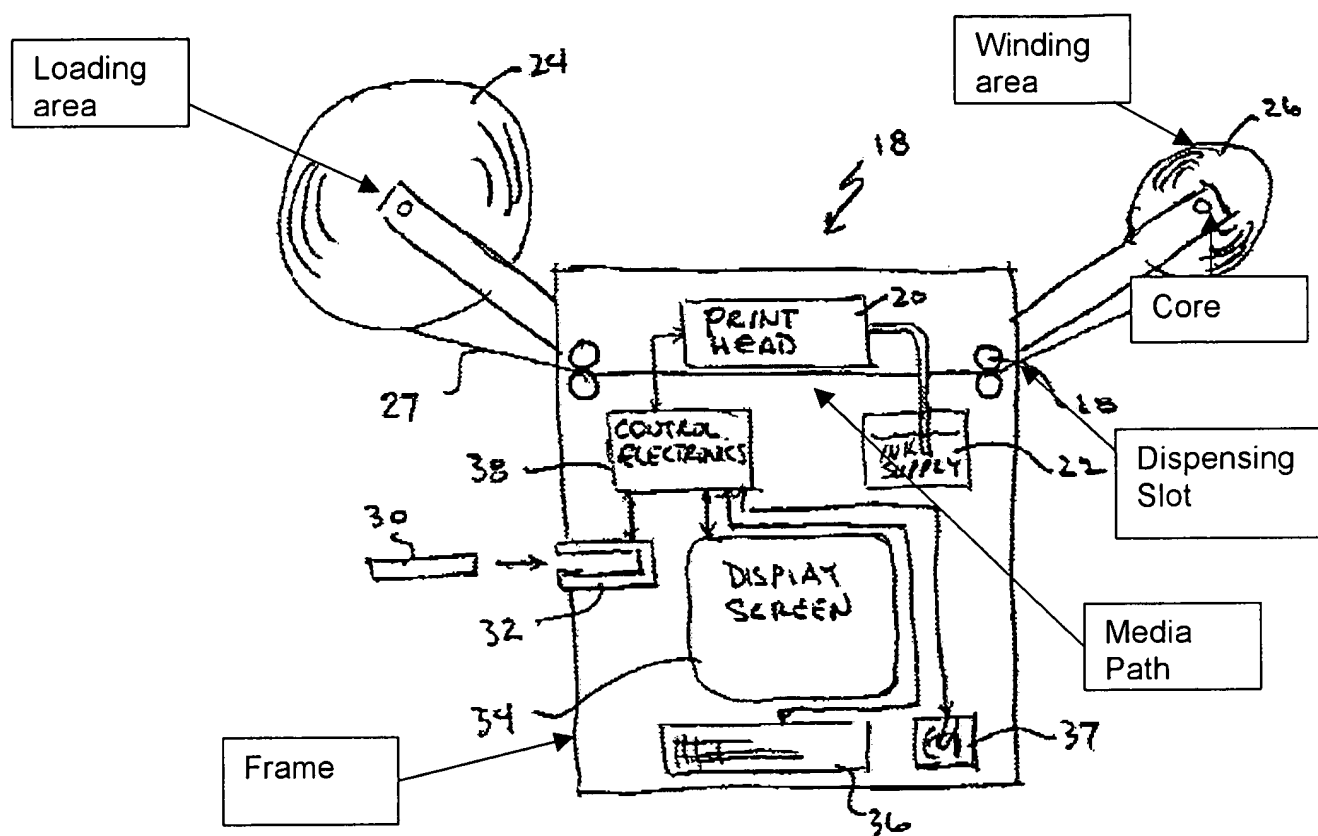
invention of Martin to include the width of wallpaper as per the customers requirements as taught by Fujii et al., since Fujii et al. teaches that it is advantageous to properly and accurately print out the wallpaper based on customer requirements and to also include a slitting/cutting mechanism as taught by Kwasny, since Kwasny improves the efficiency of cutting a web into multiple narrow sheets.

Regarding claims 12 and 14, Martin teaches providing media canister (24) to contain unprinted web and loading the canister with blank media (inherent to load the canister on the printer).

Regarding claims 17 and 18, Martin teaches a printhead (20) that is a full width color printhead that prints patterns accessible to the processor (38) and using a full width printhead (20) to print onto the web while it is motion (it is inherent that the printer is in motion).

Regarding claim 20, Martin teaches a franchisee that is instructed to operate the printer for a customer (Abstract and paragraph 001 1).

Regarding claim 46, Martin teaches a printhead (20) being supplied with inks from ink supply (22) which is remote from the printhead and which is supplied through tubing (Figure 2).



4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Goldstein (US 2002/0069078).

Martin, Fujii et al. and Kwasny all teach the claimed method including a display screen (paragraph 0058), however he does not teach a printer that acquires data from a touch-screen display which is also adapted to display the pattern to a customer of the

franchisee. Goldstein teaches a step of using a touch-screen that operates with a wallpaper creation program (Abstract, element 102 and paragraph 0058, lines 22-27). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the display screen thereof with the touch-screen display of Goldstein, since Goldstein teaches that it is advantageous to provide an easy and quicker method of entering data.

5. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Gerber et al. (WO 03/064170).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of an input device such as a scanner for capturing data. Gerber et al. teaches a method of printing wallpaper including an input device such as a scanner (24) for scanning designs and patterns that are used in wallpaper design (page 3, lines 18-20 and lines, 31-33). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a scanner as taught by Gerber et al., since Gerber et al. teaches that it is advantageous for easily inputting designs that are selected by the operator.

6. Claims 7,8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claims 1 and 4 above, and further in view of Krinsky (US Patent 6,354,212).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of providing a variety of blank media types so that they may be used in the printer, providing one or more collections of printed swatches, which correspond to patterns that the printer is able to print on demand and providing new patterns from time to time. Krinsky teaches a method of preparing customized wallpaper panels (1-4 and 3-6) that are used in the printer, a collection of samples (Column 4, Lines 11-15) and the customers have the ability to personalize or customize their own designs (Column 2, Lines 38-67 and Column 3, Lines 1-22). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a plurality of blank media types and a collection of samples as taught by Krinsky, since Krinsky teaches that it is advantageous to provide personalized custom wallpaper panels for aesthetically pleasing purposes.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of in view of Fujii et al. (US Patent 6,715,423), Kwasny (US Publication 2002/01189900) and Krinsky (US Patent 6,354,212) as applied to claims 1 and 8 above, further in view of Lapointe et al. (US 5,056,142).

Martin, Fujii et al., Kwasny and Krinsky all teach the invention claimed with the exception of swatches that are assigned a printed symbol. Lapointe et al. teaches a device that has a sample book of samples that each contain symbols (Column 1, Lines 53-60 and column 4, Lines 59-68). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a samples that contain symbols as taught by Lapointe et al., since Lapointe et al. provides a easier method of identifying a particular sample in a quick, efficient amount of time.



8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claims 1 and 12 above, and further in view Schoendienst et al. (US Patent 5,302,037).

Martin, Fujii et al., and Kwasny all teach the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer. Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al. teaches that it advantageous to provide the necessary power to accurately advance the web.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423), Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Bilek (US Patent 4,322,044).

Martin, Fujii et al. and Kwasny all teach the claimed method including loading a disposable media tote (26) into a winding area adjacent to the dispensing slot and winding a printed roll of wallpaper onto a core inside the tote (refer to figure below), however he does not explicitly disclose severing the printed roll on the core from the web. Bilek teaches a printer with a take-up roll core (39) and a paper tear bar (34) for severing the print media web (19) from the supply roll (17 and column 3, Lines 21-22).

It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a tear bar for severing as taught by Bilek, since Bilek teaches that it is advantageous to easily separate the media web from the supply roll.

10. Claims 19,38 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Sandhoo (DE 29908649).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of drying a web after it is printed on but before it is dispensed by the printer. Sandhoo teaches a dryer (no element number is provided) located between the printing area (4) and the winding area (6) for drying the printed web (8). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a dryer as taught by Sandhoo, since Sandhoo provides a dryer for quickly and efficiently drying a printed web to prevent smudging.

11. Claims 21, 35,45 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Harris et al. (US Patent 5, 161,685).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of a tote for holding cores which cooperate with a winding area and a disposable exterior in which is formed a main access flap and a pair of core access openings and the tote having an interior in which is located a disposable core which is aligned with the access

openings and exposing a molded coupling, attached to each end core, at least one core of the couplings being a driven coupling and adapted to engage a driving spindle that rotates a core .

Harris et al. teaches a tote for holding a core with a winding area including a disposable exterior (42 and also note that Taylor et al. is silent of a material of exterior that is disposable, however anything can be considered disposable) with a main access flap (46) and a pair of core access openings (44b,46b) that are comprised with bearing surfaces (column 5, lines 13-19) and the tote having an interior in which is located a disposable core (any object can be disposable), which is aligned with the access openings (Figure 5), has molded hubs (48) for supporting the core, c and an external coupling (50) that could be used to engage a rotating winding spindle.

It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a tote as taught by Taylor et al. for the purpose of providing an easy method of transporting, protecting and dispensing a roll of media.

12. Claims 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900).

Martin, Fujii et al. and Kwasny all teach the claimed method including using a printhead (20), however the prior art does not explicitly a wide selection of desire rates at which a printhead prints on a web/medium or the selection of the number of nozzles or number of ink drops for each of the printheads. However, it has been held that through routine experimentation that it would be obvious to test a wide selection of

printheads since such an experimentation would result in acquiring the best possible print quality.

13. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Nagel (US Patent 5,362,008).

Martin, Fujii et al. and Kwasny all teach the claimed invention with the exception of a case having two halves, hinged together, an area between the two halves, when closed defining a media slot and the case having internally and adjacent slot, a pair of rollers, at least one roller being a driven roller, which is supported at each end, by the case. Nagel teaches a media cartridge including a case with two halves (20a,21 and Figure 5), a media supply slot (23) located between the two halves when they are closed, a pair of rollers (39,40) inside the case and adjacent the supply slot (23) and a driven roller (40) that can be driven by an external motor (Figure 5). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the case thereof with a hinged case as taught by Nagel, since Nagel teaches that it is advantageous to provide a case that is easy to open.

14. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/0189900) as applied to claim 1 above, and further in view of Nielson et al. (US Patent 4,885,964).

Martin, Fujii et al. and Kwasny all teach the claimed invention with the exception of a chassis having end plates, slitter shafts and slitting mechanism. Nielson et al. discloses a slitting mechanism including a chassis having end plates and transverse portion (shown in Figure 1), a slitting shaft (12) having a plurality of slitters (13) with cutting edges (Figure 2). It would have been obvious to one of ordinary skill to further modify the invention of Martin to replace the case thereof with a chassis with end plates and a slitting mechanism for providing a stable mechanism for effectively cutting a web.

15. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (US Publication 2002/017692) in view of Fujii et al. (US Patent 6,715,423) and Kwasny (US Publication 2002/01189900) as applied to claim 1 above, and further in view of Schoendienst et al. (US Patent 5,302,037) and Yada (JP 2003/063700).

Martin, Fujii et al. and Kwasny all teach the claimed method with the exception of providing a motor in the printer to advance the unprinted web into the path by automatically threading the media through the printer and pilot guide. Schoendienst et al. teaches using a motor (M) for advancing a web and it should be obvious that the web will automatically thread. However, Schoendienst et al. does not teach a pilot guide. Yada teaches a pilot guide (4220) for print media (100b, Figure 15). It would have been obvious to one of ordinary skill to further modify the invention of Martin to include a motor that automatically threads a web as taught by Schoendienst et al., since Schoendienst et al. teaches that it advantageous to provide the necessary power to accurately advance the web and to include a pilot guide for guiding the print media in a desired direction so that it does not jam and disrupt the printing process.

### ***Response to Arguments***

16. Applicant's arguments filed 9/19/05 have been fully considered but they are not persuasive. With regards to applicant's comments on page 11, section II, the applicant points out the fact that Martin does not teach selecting the width of a wallpaper and/or slitting the web. The examiner notes that the Martin was not relied upon for those particular elements.

On page 12, applicant relies upon the fact that Figure 3E of Fujii et al. teaches the customer entering the size of the wall. However, it appears that the customer is entering the acquired width. It would be assumed that one of ordinary skill in the art would recognize that the printer of Fujii et al. would reject a larger size width of the wall and instead calculate the dimensions in width sizes of wallpaper. The examiner also notes that Fujii et al. teaches a more complicated process, however the same results are obtainable with the apparatus.

Also, on page 12, in regards to comments directed towards Kwasny et al., applicant argues that Kwasny et al. teaches the minimal paper loss and the applicant's invention would involve actually wasting one portion of the web. The arguments are noted, however the limitation is not claimed and Kwasny et al. would still appear to teach the claimed limitation of slitting the web.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other(F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marissa L Ferguson  
Examiner  
Art Unit 2854

MLF



**ANDREW H. HIRSHFELD**  
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